

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MERCEDES-BENZ USA, LLC, AND  
MERCEDES-BENZ U.S. INTERNATIONAL, INC.,  
Petitioner,

v.

INNOVATIVE DISPLAY TECHNOLOGIES LLC,  
Patent Owner.

---

Case IPR2015-00360  
Patent 7,300,194 B2

---

Before LORA M. GREEN, THOMAS L. GIANNETTI, and  
BEVERLY M. BUNTING, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder  
*37 C.F.R. § 42.108*  
*37 C.F.R. § 42.122(b)*

## I. INTRODUCTION

Mercedes-Benz USA, LLC and Mercedes-Benz U.S. International, Inc. (collectively, “Petitioner” or “Mercedes-Benz”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 4–6, 16, 22, 23, 27, 28, and 31 (“the challenged claims”) of U.S. Patent No. 7,300,194 B2 (Ex. 1001, “the ’194 patent”), and concurrently filed a Motion for Joinder (Paper 3, “Mot.”). The Motion for Joinder seeks to join this proceeding with *LG Display Co., Ltd. v. Innovative Display Technologies LLC*, Case IPR2014-01097 (“the LG IPR”). Mot. 1. Patent Owner filed a Preliminary Response (Paper 18), as well as an Opposition to the Motion for Joinder (Paper 7). For the reasons described below, we institute an *inter partes* review of all the challenged claims and grant Petitioner’s Motion for Joinder.

## II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds as those on which we instituted review in the LG IPR. On January 13, 2015, we instituted a trial in the LG IPR on the following grounds:

Reference(s)	Basis	Claims Challenged
Pristash <sup>1</sup>	§ 103	1, 4–6, and 28
Funamoto <sup>2</sup>	§ 102	1, 16, 22, 23, 27, and 31
Funamoto	§ 103	4, 5, and 6
Kobayahi <sup>3</sup>	§102	28

<sup>1</sup> Pristash, U.S. Patent No. 5,005,108, issued Apr. 2, 1991 (Ex. 1006).

<sup>2</sup> Funamoto, U.S. Patent No. 5,619,351, issued Apr. 8, 1997 (Ex. 1007).

Nishio <sup>4</sup>	§ 102	1, 4–6, and 28
---------------------	-------	----------------

*LG Display Co., Ltd. v. Innovative Display Technologies LLC*, Case IPR2014-01097, slip. op. at 18 (PTAB January 13, 2015) (Paper 9).

In view of the identity of the challenge in the instant Petition and in the petition in the LG IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted the LG IPR. We do not institute *inter partes* review on any other grounds.

### III. GRANT OF MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of inter partes review proceedings:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

As the moving party, Mercedes-Benz bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5,

---

<sup>3</sup> Kobayashi, U.S. Patent No. 5,408,388, issued Apr. 18, 1995 (Ex. 1011).

<sup>4</sup> Nishio, U.S. Patent No. 5,598,280, issued Jan. 28, 1997 (Ex. 1012).

IPR2015-00360  
Patent No. 7,300,194 B2

<http://www.uspto.gov/patentsapplication-process/appealing-patentdecisions/trials/patent-reviewprocessing-system-prps-0> (last visited April 1, 2015).

The Petition in this proceeding has been accorded a filing date of December 4, 2014 (Paper 6), which is before the date of institution in the LG IPR, which was instituted on January 13, 2015 (LG IPR, Paper 9). The Petition, therefore, satisfies the joinder requirement of being filed within one month of our instituting a trial in the LG IPR. 37 C.F.R. § 42.122.

In its Motion for Joinder, Mercedes-Benz contends that the grounds asserted in the instant Petition are

[T]he same grounds of unpatentability LG asserted in the LG IPR; Petitioners' arguments regarding the asserted references are identical to the arguments LG raised in the LG IPR; and Petitioners have submitted, in support of their petition, the same declaration of the technical expert that LG submitted in support of its petition (excluding some minor changes made to reflect Petitioners' engagement of the same expert).

Mot. 6. Mercedes-Benz represents that joinder will not prevent the Board from completing its review in "the statutorily prescribed timeframe," and that "joinder will ensure the Board's efficient and consistent resolution of issues surrounding the invalidity of the '194 patent." *Id.* at 1. According to Mercedes-Benz, the Board can accomplish this by requiring "consolidated filings and coordination among petitioners." *Id.* at 2. Thus, Mercedes-Benz contends, the instant proceeding does not raise any issues that have not already been raised in the LG IPR. *Id.* at 6.

Patent Owner opposes joinder, contending that Petitioner argues only that the grounds asserted in the instant Petition and the one asserted in the

IPR2015-00360  
Patent No. 7,300,194 B2

LG IPR are identical, and has not provided any, additional reasoning as to why joinder is appropriate. Paper 7, 6 (citing *Unified Patents, Inc. v. Personalweb Technologies, LLC and Level 3 Communications, LLC*, Case IPR2014-00702, slip. op. at 4 (PTAB January 13, 2015) (Paper 12)).

As discussed above, joinder is discretionary. In IPR2014-00702, cited by Patent Owner, the panel noted that joinder is not automatic, but is discretionary based on the particular circumstances of each proceeding. In the instant proceeding, we agree with Mercedes-Benz that joinder with the LG IPR would promote the efficient resolution of those proceedings. Mercedes-Benz has brought the same challenges as presented by the LG IPR, thus, the substantive issues in this IPR would not be unduly complicated by joining with the LG IPR because joinder merely introduces the same grounds presented originally in the LG IPR, where all of the prior art is of record. Moreover, the instant proceeding was filed before we instituted trial in the LG IPR. Finally, Patent Owner will be able to address the challenges in a single proceeding.

Patent Owner contends further that Petitioner in the instant proceeding filed its Petition well after the Petition was filed in the LG IPR, and thus it “should have known that a decision on institution on the first IPR was imminent and that its argument on this point would be moot by the time joinder briefing was completed.” Paper 7, 6. Moreover, Patent Owner notes that the trial schedule has been set in the LG IPR, asserting that Petitioner would most likely not agree to proceeding on that schedule, as it does not mention that possibility in its Motion for Joinder. *Id.* at 7.

We acknowledge that Patent Owner has filed its Response to the Petition in IPR2014-01097. LG IPR, Paper 19. As the grounds on which

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.